



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,767	11/27/2001	Ming-Sum Fang	12283	7588

25763 7590 09/22/2006

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/993,767	Applicant(s) FANG ET AL.	
	Examiner Calvin L. Hewitt II	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-53 have been examined.

Response to Amendments/Arguments

2. Applicant is of the opinion that the prior art does not teach monitoring a card terminal to detect at least one activity performed at a card terminal and upon detecting the activity downloading a requested application to the terminal. The Examiner respectfully disagrees. Desai et al. teach a method and system for configuring a card terminal by downloading an application to said terminal (abstract; column 3, lines 4-11; column/line 6/66-7/24; column/line 12/56-13/30) after monitoring and detecting the terminal (figure 4) for a user's selection of an application to be downloaded (column 13, lines 1-30).

Applicant recites claimed limitations in terms of optional or conditional language ("upon detecting"). According to the MPEP, however, optional or conditional language does not further limit a claim (MPEP, 2106, section II, C). Therefore, Applicant's claims are broad enough to read on prior art where an activity is *not* detected.

Applicant's arguments with respect to claims 1-53 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al., U.S. Patent No. 6,877,093 in view of Ohki et al., U.S. Patent No. 6,644,553.

As per claims 1-53, Desai et al. teach a method and system for downloading an application to a card terminal (figure 4) comprising:

- monitoring a card terminal to detect at least one activity (process a transaction or close a batch) performed at the card terminal and upon detecting the monitored activity downloading, by generating and transmitting a data stream over TCP/IP, the application to the card terminal wherein the terminal is reconfigured based on the application (figure 4; column 3, lines 4-11; column/line 6/66-7/24; column 10, lines 15-33; column/line 12/56-13/30)
- downloading an application to provide an indication of information to be printed on a receipt, audio information to be generated at card

terminal or visual information to be displayed (column 3, lines 4-11;
column 7, lines 24-37; column 8, lines 23-46; column 13, lines 6-29)

- transmitting a message to the card terminal relating to the triggering of the downloading of configuration data (column 9, lines 41-46; column/line 12/56-13/30)

Desai et al. teach a user at a card terminal communicating with a web server over the Internet (e.g. dial-up, high-speed, etc.) (column/line 5/60-6/8; column 9, lines 42-46; column 10, lines 2-15) wherein the user and the server interact using a website (figure 8; column 12, lines 56-65) or GUI (column 9, lines 41-46).

However, Desai et al. do not specifically recite a user receiving a request from the server to download the application. Ohki et al. teach a user receiving a request from a user to download an application to a card terminal (column 6, lines 18-31). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Desai et al. and Ohki et al. in order to allow a user to determine the best time for an application to be downloaded.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 3600
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

or:

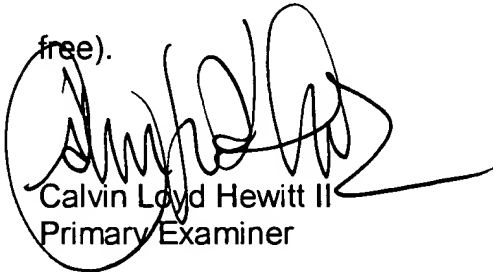
(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

Art Unit: 3621

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", is written over a circular stamp. The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Calvin Lloyd Hewitt II
Primary Examiner

September 13, 2006